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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/378,217	08/19/1999	JEFFRY JOVAN PHILYAW	PHLY-24.707	8857

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EXAMINER	
NGUYEN, CHAU T	
ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/378,217	PHILYAW ET AL.	
	Examiner	Art Unit	
	Chau Nguyen	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 May 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Amendment, received on 09/26/2003, has been entered. Claims 1-10 are presented for examination.

Terminal Disclaimer

2. The application/patent being disclaimed has been improperly identified since the number used to identify the 6,622,165 being disclaimed is incorrect. The correct number is 6,615,268.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of Philyaw et al., U.S. Patent No. 6,615,268. Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the claimed invention is the similar as the context of the cited claims of the U.S. Patent No. 6,615,268.

5. All the claims 1-10 of the application have similar limitations to claims 1-9 of Philyaw et al., U.S. Patent No. 6,615,268 except the limitation "embedding a unique perceivable code, which does not containing routing information". Therefore, claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,615268 and in view of Wolzien, Patent No. 5,761,606 for the limitation "embedding a unique perceivable code, which does not containing routing information".

The Philyaw et al. reference disclose a method for controlling a computer with recorded information of a digital audio tape, comprising: embedding a unique code in the recorded audio information of the digital audio tape, extracting the unique code with an extractor during output of the recorded audio information to a user, transmitting the unique code to a remote location on the network in accordance with routing information stored at the user. Wolzien discloses an on line information provider address (unique perceivable code) embedded in a video or audio program is encoded in a vertical blanking interval, and the on line information provider address is detected and decoded from the electronic signal and used in establishing a direct signal communication link to the online information provider (thus, the address does not contain routing information) (Abstract and col. 3, line 25 – col. 4, line 48). Since Wolzien discloses address embedded in video or audio program, thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Wolzien and Philyaw et al. to include embedding a unique perceivable code, which does not contain routing information. Wolzien suggests that by providing automated and direct user access to online information providers through an address embedded in a video or audio program signal would obtain several benefits such as users could easily locate additional materials provided in text or still picture by the producers of the video program by accessing more information from the producers digitally through the online address.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1, 4-5, 6, and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendinelli et al., U.S. Patent No. 6,061,719 in view of Ullman et al., U.S. Patent No. 6,018,768, and further in view of Wolzien, U.S. Patent No. 5,761,606.

8. As to claim 1, Bendinelli et al. (Bendinelli) discloses the invention substantially as claimed.

the unique code in close association with vendor information (col. 2, line 51 – col. 3, line 12 and col. 3. line 57 – col. 4, line 13: teaches a URL or other type of network information identifier which identifies a web site (vendor information));

extracting the unique code with an extractor during output of the recorded information to a user at a user location disposed on a network (col. 3, line 13 – col. 4, line 13 and col. 5, line 57 – col. 6, line 11: teaches a decoder extracts and embedded URL or other type of network information identifier from a closed caption stream (output information) and delivers it to a computer via a suitable connection (network));

in response to extracting the unique code, transmitting the unique code to a remote location on the network in accordance with routing information accessible at the user location, wherein the vendor product information is returned to the user location for processing (col. 2, line 51 – col. 3, line 12 and col. 5, line 57 – col. 6, line 11: teaches from extracting the URL or other network information identifier (unique code) identifying a web site at a server (remote location) and wherein a web page (vendor information) is delivered to the computer for display).

However, Bendinelli does not explicitly disclose the unique code in recorded information of the compact disk and which unique code is embedded within the video/audio bandwidth of the recorded information, and the unique code will be output during normal playback of the compact disk and within the video/audio bandwidth thereof. Ullman et al. (Ullman) discloses on col. 5, lines 28-30, col. 9, lines 4-35, and col. 10, lines 4-25: teaches operating a DVD player at a user site to read a video program with embedded URLs (unique code) which is stored or recorded in a digital video disk and video program is displayed on the user site. Ullman also discloses the URLs (unique codes) identifying the Web site and time stamps are sent automatically to the desktop of each student either during playback of a pre-recorded program or during a live event (col.10, lines 33-49). Since Ullman discloses a system for integrating video programming with the information resources of the Internet, which is similar to synchronized presentation of television programming and web content of Bendinelli, It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a digital video disk (DVD) storing video program with embedded URLs and DVD player to retrieve video program to display on user site and

the URLs (unique codes) identifying the Web site and time stamps are sent automatically to the desktop of each student either during playback of a pre-recorded program or during a live event as taught by Ullman, and extract a unique code to identify the location of a server corresponding that unique code, as taught by Bendinelli, in a digital computing environment. The motivation to do so would have been to provide a user friendly environment by giving customers additional information automatically through the Internet.

However, Bendinelli and Ullman do not explicitly disclose embedding a unique perceivable code, which does not contain routing information. In the same field of endeavor, Wolzien disclose an on line information provider address (unique perceivable code) embedded in a video or audio program is encoded in a vertical blanking interval, and the on line information provider address is detected and decoded from the electronic signal and used in establishing a direct signal communication link to the online information provider (thus, the address does not contain routing information) (Abstract and col. 3, line 25 – col. 4, line 48). Since Wolzien discloses address embedded in video or audio program, which is similar to a system for integrating video programming with the information resources of the Internet of Ullman and synchronized presentation of television programming and web content of Bendinelli, thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Wolzien and Bendinelli and Ullman to include embedding a unique perceivable code, which does not contain routing information. Wolzien suggests that by providing automated and direct user access to online information providers through an address embedded in a video or audio program signal would obtain several

benefits such as users could easily locate additional materials provided in text or still picture by the producers of the video program by accessing more information from the producers digitally through the online address.

9. As to claim 4, Bendinelli and Ullman and Wolzien (Bendinelli-Ullman-Wolzien) disclose the network is a global communication network that provides a universal resource locator (URL) for each location on the network and the routing information is comprised of the URL for the location (Bendinelli, col. 2, line 51 – col. 3, line 12).

10. As to claim 5, Bendinelli-Ullman-Wolzien disclose the unique perceivable code is an audible tone (Bendinelli, col. 2, line 51 – col. 4, line 13: teaches network information identifier can be embedded in any other type of signal; Wolzien: Abstract, and col. 3, line 25 – col. 4, line 48: links video and audio program content with online video or audio information signal content).

11. Claims 2-3 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendinelli-Ullman-Wolzien as applied to claims 1 and 4-5 above, and further in view of Hitzelberger, U.S. Patent No. 6,061,368.

12. As to claim 2, Bendinelli-Ullman-Wolzien disclose the invention substantially as claimed as described supra. However, Bendinelli-Ullman-Wolzien do not explicitly teach an intermediate location on the network for comparing the received unique code with the stored vendor routing information in the database. Hitzelberger discloses on

col. 4, lines 9-56: a routing engine (intermediate location) for matching source identifiers with the destination identifiers from a cache (stored vendor routing information) in the routing engine. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a routing engine (intermediate location), as taught by Hitzelberger, to identify a web site at server using a code, as taught by Bendinelli-Ullman-Wolzien, in a network environment. The motivation to do so would have been to provide a routing engine to match the source identifier with the destination identifiers stored in the cache to be able to identify the web page (vendor information) at a server for interconnection increasing the reliability in establishing connection between source and destination.

13. As to claim 3, Bendinelli-Ullman-Wolzien and Hitzelberger (Bendinelli-Ullman--Wolzien Hitzelberger) disclose the user location further includes user ID information that uniquely identifies the user location (Hitzelberger, col. 4, line 9-56: teaches a source identifier), and

wherein the database at the intermediate node includes user profiles information which is associated therein with the user ID information of the user location (Ullman, col. 3, line 44 – col. 4, line 4), and

wherein the step of transmitting the unique perceivable code over the network to the intermediate note also includes transmitting the user ID information to the intermediate location, and the step of matching further comprises matching the received user ID information of the user location with stored profile information associated with the received user ID information (Wolzien, Abstract, and col. 3, line 25 – col. 4, line 48;

Hitzelberger, col. 4, line 9-56: teaches routing engine (intermediate note) which includes identifier, and a matching function for comparing source identifier with a destination identifiers stored in cache to be encoded in a packet that is transmitted to the destination), and

wherein the step of transmitting the matching vendor routing information back to the user location further includes appending to the vendor routing information the stored profile information, and wherein the stored profile information is transmitted to the remote vendor information location via the user location (Hitzelberger, col. 4, line 9-56).

14. Claims 6-10 have similar limitations as discussed in the method of claims 1-5; therefore, they are rejected under the same rationale.

Response to Arguments

15. In the remarks, Applicants argued in substance that

(A) "Applicants believe that none of the references, taken singularly or in combination, represent a storage media such as DVD that has stored thereon within the video/audio bandwidth of the program a unique identifier that has no embedded URL, i.e., there is no routing information stored in the unique code."

As to point (A), Wolzien disclose an on line information provider address (unique perceivable code) embedded in a video or audio program is encoded in a vertical

blanking interval, and the on line information provider address is detected and decoded from the electronic signal and used in establishing a direct signal communication link to the online information provider (thus, the address does not contain routing information) (Abstract and col. 3, line 25 – col. 4, line 48). Since Wolzien discloses address embedded in video or audio program, which is similar to a system for integrating video programming with the information resources of the Internet of Ullman and synchronized presentation of television programming and web content of Bendinelli, thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Wolzien and Bendinelli and Ullman to include embedding a unique perceivable code, which does not contain routing information. Wolzien suggests that by providing automated and direct user access to online information providers through an address embedded in a video or audio program signal would obtain several benefits such as users could easily locate additional materials provided in text or still picture by the producers of the video program by accessing more information from the producers digitally through the online address.

16. Applicant's arguments and amendments filed on 09/26/2003 have been fully considered but they are not deemed fully persuasive. Please see the rejection and response to arguments above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (703) 305-4639. The Examiner's future phone number is (571) 272-4092, which will be effective sometime in October 2004. The examiner can normally be reached at 8:00 am – 5:00 pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703) 305-9792. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3230.

Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20131

Or Faxed to:

(703) 872-9306, (for **formal communications**; please mark "EXPEDITE PROCEDURE").

Or:

(703) 746-7240 (for **informal or draft communications**, please label "PROPOSED" or "DRAFT").

Or:

(703) 872-9306 (for **After Final Communications**).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Chau Nguyen
Patent Examiner
Art Unit 2176

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER